

### **REMARKS**

This is a full and timely response to the outstanding non-final Office Action mailed January 31, 2005 (Paper No. 20050126). Upon entry of this response, claims 1-19 are pending in the application. In this response, claims 1, 7, and 15 have been amended. Applicant respectfully requests that there be reconsideration of all pending claims.

1. **Examiner Interview**

A telephone interview between the Examiner and Applicant's representatives (Jeff Kuester and Karen Hazzah) took place on March 2, 2005. During the interview, the *Emura* reference was discussed with reference to independent claim 1. Applicant's representatives explained some of the differences between claim 1 and *Emura*, and the Examiner suggested potential claiming strategies to express these differences. Applicant wishes to thank the Examiner for his time.

2. **Rejection of Claims 1, 2, 5, 6, 8, and 9 under 35 U.S.C. §102**

Claims 1, 2, 5, 6, 8, and 9 have been rejected under §102(e) as allegedly anticipated by *Emura* (U.S. 6,453,340). A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983).

a. **Claim 1**

Applicant respectfully submits that the rejection of claim 1 has been overcome by the claim amendments made herein. Applicant respectfully submits that *Emura* fails to teach, disclose or suggest at least "searching a database of attachment files that were attached to

previously-received e-mail communications for a copy of the attachment file from the received e-mail communication” as recited in amended claim 1.

Claim 1 has been amended to further clarify the contents of the database. Specifically, claim 1 recites “searching a database of attachment files *that were attached to previously-received e-mail communications.*” In processing a particular received e-mail message with an attachment, the terminal in *Emura* examines only files that are attached to the e-mail message being processed. (FIG. 6.) The terminal in *Emura* does not examine or access or search files “that were attached to previously-received e-mail communications.”

For at least the reason that *Emura* fails to disclose, teach or suggest this feature, Applicant respectfully submits that amended claim 1 overcomes the rejection. Therefore, Applicant requests that the Examiner’s rejection of claim 1 be withdrawn.

b. Claim 7

Applicant respectfully submits that the rejection of claim 7 has been overcome by the claim amendments made herein. Applicant respectfully submits that *Emura* fails to teach, disclose or suggest at least “comparing the extracted attachment file header information with header information from attachment files previously stored in the mail store to determine whether the attachment files received with the e-mail message communications are duplicates of previously stored files” as recited in amended claim 7.

Claim 7 has been amended to recite “extracting attachment file header information,” which is not disclosed, taught, or suggested by *Emura*. The only discussion of headers in *Emura* is a header of the e-mail message itself (Col. 9, lines 10-25), and not a header of the attachment file. Furthermore, nothing in *Emura* suggests that creating an alternate URL includes comparing attachment file header information, as recited in amended claim 7: “comparing the extracted

attachment file header information with attachment file header information from other attachment files.”

For at least the reason that *Emura* fails to disclose, teach or suggest this feature, Applicant respectfully submits that amended claim 7 overcomes the rejection. Therefore, Applicant requests that the Examiner’s rejection of claim 7 be withdrawn.

c. Claim 15

Applicant respectfully submits that the rejection of claim 15 has been overcome by the claim amendments made herein. Applicant respectfully submits that *Emura* fails to teach, disclose or suggest at least “e-mail message attachment file checking software for determining whether attachment files in received e-mail message communications are duplicates of attachment files that were attached to previously-received e-mail message communications in the mail store” as recited in amended claim 15.

Claim 15 has been amended to further clarify how duplicates are determined. Specifically, claim 15 recites “determining whether attachment files in received e-mail communications are duplicates of attachment files *that were attached to previously-received e-mail* communications in the mail store.” In processing a particular received e-mail message with an attachment, the terminal in *Emura* examines only files that are attached to the e-mail message being processed. (FIG. 6.) The terminal in *Emura* does not examine or access or search files “that were attached to previously-received e-mail communications.”

For at least the reason that *Emura* fails to disclose, teach or suggest this feature, Applicant respectfully submits that amended claim 15 overcomes the rejection. Therefore, Applicant requests that the Examiner’s rejection of claim 15 be withdrawn.

d. Claims 2, 4, 6, 9, 16, and 17

Since claims 1, 7, and 15 are allowable, Applicant respectfully submits that claims 2, 4, 6, 9, 16, and 17 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicant respectfully requests that the rejection of claims 2, 4, 6, 9, 16, and 17 be withdrawn.

3. Rejection of Claims 3, 5, 8, 10-14, 18, and 19 under 35 U.S.C. §103

Claims 3, 5, 8, 10-14, 18, and 19 have been rejected under §103(a) as allegedly obvious over *Emura* (U.S. 6,560,639) in view of *Geiger et al.* (U.S. 6,073,142). Applicant respectfully traverses this rejection. Since claims 1, 7, and 15 are allowable, Applicant respectfully submits that claims 3, 5, 8, 10-14, 18, and 19 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicant respectfully requests that the rejection of claims 3, 5, 8, 10-14, 18, and 19 be withdrawn.

4. Traversal of Official Notice in Rejection of Claim 8

Applicant respectfully traverses the following Official Notice statement in the rejection of claim 8:

An Official Notice is taken that the detecting an illegal duplicate of a Web attached was well-known in the art [see Shinoda reference].  
(Office Action, p. 4, paragraph 8).

Applicant first notes that claim 8 does not recite “detecting an illegal duplicate of a Web attached” as stated in the rejection, but instead recites “determining whether attachment files in received e-mail communications are duplicates.” In addition, Applicant respectfully asserts that the claimed feature is not capable of instant and unquestionable demonstration as being well known. Applicant respectfully submits that the Official notice is improper, because the Office

Action did not include specific factual findings predicated on sound technical and scientific reasoning to support the conclusion. Such specific findings and reasoning are required by MPEP § 2144.03.

5. Miscellaneous Findings

a. Inherency

Applicant respectfully traverses the finding in the Office Action that the following feature is an inherent feature of database searching: “the database of attachment files is searched by performing a checksum against the attachment file of the received e-mail message communication.” (Office Action, p. 3, paragraph 5.) This feature is not necessarily present in a database system. For example, a search could hypothetically be performed by a byte-wise comparison instead of a checksum comparison. In accordance with *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2D (BNA) 1949, 1950-51 (Fed. Cir. 1999), Applicant traverses that finding as being inadequate to show why the claimed feature is “necessarily present” in the reference. Consequently, because of the lack of extrinsic evidence required under *In re Robertson*, the Office Action’s statement is merely conclusory and not adequately supported, and the rejection of claim 5 should be withdrawn.

b. Well-known

Applicant respectfully traverses the finding in the Office Action that “it was well-known in the e-mail message art that an e-mail message could be analyzed based on the POP rules and properties as taught by Geiger.” (Office Action, p. 6, paragraph 11.) Applicant respectfully submits that the subject matter should not be considered well-known to one of ordinary skill in the art, because the Office Action did not include specific factual findings predicated on sound

technical and scientific reasoning to support the conclusion. Such specific findings and reasoning are required by MPEP § 2144.03.

**CONCLUSION**

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and presently pending claims 1-19 be allowed to issue. The omission of responsive arguments herein to any other statements in the Office Action are not intended to be construed as implied admissions that Applicant agrees with the statements. If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

Respectfully submitted,

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& RISLEY, L.L.P.**

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